



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/183,791	10/30/98	JACOUES	P FMSI-24.440

THOMAS R. FELGER, ESQ.
BAKER BOTTS LLP
2001 ROSS AVENUE
DALLAS TX 75201

LMC1/0811

EXAMINER

KAZIMI, H

ART UNIT

PAPER NUMBER

2765

13

DATE MAILED: 08/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/183,791

Applicant(s)

Jacoves et al.

Examiner

Hani Kazimi

Group Art Unit
2765



☒ Responsive to communication(s) filed on May 10, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-51 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-51 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. This communication is in response to the Continued Prosecution Application (CPA) request transmittal and the amendment filed on May 10, 2000.

Status of Claims

2. Of the original claims 1-46, claims 1-5, 17, 19, 23, 25-29, 39, 41, and 45 have been amended in the amendment filed on October 15, 1999. In the amendment filed on May 10, 2000, claims 1-3, 6-10, 12, 14-27, 30-34, 36-38, 40, 41, and 43-46 have been amended, and claims 47-51 have been added. Therefore, claims 1-51 are under prosecution in this application.

Response to Applicants' Amendment

3. The Examiner acknowledges Applicants' amended claims 1, and 25 to overcome the 35 U.S.C. § 112 2nd paragraph rejection, and therefore withdraws the prior office action's rejection regarding this matter. Applicants' remaining traversals are discussed under the 35 U.S.C. § 102, and 35 U.S.C. § 103 rejections below.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2765

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 7, 14-21, 23, 25-27, 31, 36-43, 45, and 47-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Greer et al. European Pat. No. 0 511 463 A2 as discussed in paragraphs 9, and 2, of paper numbers 4, and 7 respectively.

Further: Claims 1, and 25, Greer teaches the step of generating the redemption value for the redeemable item based on the bundle totals, the redemption value representing a discount available for use in a subsequent purchase transaction, the subsequent purchase transaction comprising the redeemable item (col 5, lines 30-50, and col. 9, lines 29-51).

Claims 47 and 49, Greer teaches that the step of generating the redemption value for the redeemable item based on the bundle totals comprising summing the bundle totals (col. 5, lines 30-50, and col. 7, lines 10-31).

Claims 48 and 50, Greer teaches the step of providing redemption information comprising the redemption value and for each bundle, the unique code associated with the discount triggering items in the bundle and the associated bundle total (col. 9, lines 29-51).

Serial Number: 09/183,791

4

Art Unit: 2765

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

8. Claims 4-6, 8-13, 22, 24, 28-30, 32-35, 44, and 46 are rejected under 35 U.S.C. 103(a) as discussed in paragraphs 11-16, and 2, of paper numbers 4, and 7 respectively.

9. Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greer et al. European Pat. No. 0 511 463 A2.

Claim 51, Greer teaches the method steps as applied in claims 1, and 25 above.

Greer fails to explicitly teach the use of a credit in stead of a discount as in the above claims.

Serial Number: 09/183,791

5

Art Unit: 2765

Official Notice is taken that issuing a credit to a consumer is old and well known in the art. For example, a consumer that over pays a monthly bill, the amount that has been over paid shows as a credit on the next bill.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Greer to include the use of a credit issuance to the consumer because, it greatly improves the efficiency of the system, and provides a system that is user friendly.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann, can be reached at (703) 308-7791.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Hani.Kazimi

August 8, 2000



ERIC W. STAMBER
PRIMARY EXAMINER